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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,214	01/14/2005	Ralf Deisenhofer	14219-077US1/P2002,0617	1526
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FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER THOMAS, ERIC W	
			ART UNIT	PAPER NUMBER
			2831	
DATE MAILED: 05/16/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/522,214

Applicant(s)

DEISENHOFER ET AL.

Examiner

Eric Thomas

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-20 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 10 and 11 is/are rejected.
- 7) ☒ Claim(s) 6, 8, 9 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

INTRODUCTION

The examiner acknowledges, as recommended in the MPEP, the applicant's submission of the amendment dated 3/22/06. At this point, claims 1, 4, 7-8, 19 have been amended. Thus claims 1-20 are pending in the instant application.

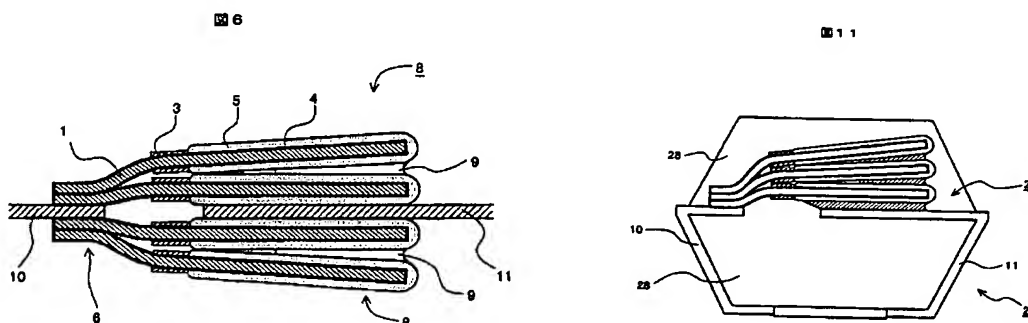
Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 7, 10-11, are rejected under 35 U.S.C. 102(b) as being anticipated by Sakai et al. (WO 00/74091).



Sakai et al. disclose in fig. 6, & 11, a surface mounted component comprising an external contact (10); and components (fig. 6) that are arranged in proximity to each other, the components comprising terminals (1 – connected to 10) wherein the external contact is connected to at least one of said terminals (lower 1) by a spot weld, wherein

the external contact defines a contact surface on an assembly area of the surface-mounted component and wherein the external contact comprises an area that is free of spot welds (note US 6,661,645 – col. 12 lines 65-66 – corresponding US case) .

Regarding claim 2, Sakai et al. disclose the external contact is L-shaped and comprises a leg, the leg defining the contact surface.

Regarding claim 3, Sakai et al. disclose the external contact comprises the terminals.

Regarding claim 4, Sakai et al. disclose at least a part of each terminal is inside the component.

Regarding claim 5, Sakai et al. disclose the external contact and the terminals comprise separate parts of the surface-mounted components.

Regarding claim 7, Sakai et al. disclose the components are stacked vertically, wherein a base area of a bottom component in the stack of the components comprises the assembly area; and wherein at least part of a terminal of a top component in the stack of components is bent downwards.

Regarding claim 10, Sakai et al. disclose the components are arranged horizontally to form a structure; wherein a side face of the structure comprises the assembly face.

Regarding claim 11, Sakai et al. disclose the external contact comprises at least two external contacts and wherein the terminals are substantially parallel to the at least two external contacts at points where the terminals connect to the at least two external contacts.

Allowable Subject Matter

3. Claims 13-20 are allowed.
4. Claims 6, 8-9, 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
5. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach or suggest (taken in combination with the other claimed features) at least part of each of the terminals extends along a side of the surface-mounted component (claim 6); and connecting the terminals to the at least two external contacts, the terminals being connected to the at least two external contacts by spot welding (claims 13-20).

Response to Arguments

6. Applicant's arguments filed 3/22/06 have been fully considered but they are not persuasive.
7. In response to applicant's argument that Sakai does not disclose the elements are connected together by spot welding, Sakai discloses (note US 6,661,645 – col. 12 lines 65-66 – corresponding US case) the lower surface of the anode part (6) and the lead frame surface (23) are bonded to each other by spot welding.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Thomas whose telephone number is 571-272-1985. The examiner can normally be reached on Monday - Friday 6:30 AM - 3:45 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-1984. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ewt

 5-11-06
ERIC W. THOMAS
PRIMARY EXAMINER